

## REMARKS

Interview request

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendments. Applicants request the Examiner call Applicants' representative at (858) 720-5133.

Status of the Claims*Pending claims*

Claims 216 to 240 are pending.

*Claims added in this response*

Claims 218 and 221 to 240 are canceled without prejudice or disclaimer, and claims 241 to 265 are added; thus, after entry of this amendment claims 216, 217, 219, 220 and 241 to 265 will be pending and under consideration.

*Outstanding Rejections*

Claims 216, 217, 219 and 220, are rejected under 35 U.S.C. §112, first paragraph, written description requirement. Claims 216, 217, 219 and 220, are rejected under 35 U.S.C. §112, second paragraph. Claims 216, 217, 219 and 220, are rejected under 35 U.S.C. §112, first paragraph, enablement requirement.

Applicants respectfully traverse all outstanding objections to the specification and rejection of the claims.

Support for the Claim Amendments

The specification as filed sets forth an extensive description of the invention in the new and amended claims. For example, support for claims and methods encompassing use of polypeptides that have a xylanase activity under various pH conditions can be found, *inter alia*, on page 20, lines 5 to 12, of PCT/US03/19153, filed June 16, 2003 (published as WO 03/106654, on December 24, 2003). Accordingly, no new matter has been added and the amendment can be properly entered.

The Group Restriction Requirement and Election

The Office alleged that the pending claims of the application are directed to six (I to VI) separate and distinct inventions under 35 U.S.C. §121.

Applicants elected Group I, drawn to *inter alia* methods of making a composition comprising a xylanase, including claims 216 and 217, with traverse.

Claim Objection

Claims 219 and 220 are objected to, as discussed on page 5, lines 8 to 9, of the OA. The instant amendment addresses this issue.

Issues Under 35 U.S.C. § 112, first paragraph – written description requirement

Claims 216, 217, 219 and 220, are rejected under 35 U.S.C. §112, first paragraph, written description requirement, for reasons set forth on pages 5 to 6, and pages 14 to 15, of the OA. The instant amendment addresses this issue.

According, in light of the instant amendment and these remarks, Applicants respectfully submit that the rejection under the section 112 written description requirement can be properly withdrawn.

Issues Under 35 U.S.C. § 112, second paragraph

Claims 216, 217, 219 and 220, are rejected under 35 U.S.C. §112, second paragraph, for reasons set forth on pages 6 to 14, of the OA. The instant amendment addresses this issue.

According, in light of the instant amendment and these remarks, Applicants respectfully submit that the rejection under section 112 second paragraph can be properly withdrawn.

Issues Under 35 U.S.C. § 112, first paragraph – enablement requirement

Claims 216, 217, 219 and 220, are rejected under 35 U.S.C. §112, first paragraph, enablement requirement, for reasons set forth on pages 15 to 18, of the OA. The instant amendment addresses this issue.

According, in light of the instant amendment and these remarks, Applicants respectfully submit that the rejection under the section 112 enablement requirement can be properly withdrawn.

Issues under 35 U.S.C. §102

Claims 216, 217, 219 and 220 are rejected under 35 USC §102(b) as allegedly anticipated by Vehmaanpera, USPN 5,935,836, issued August 10, 1999, (hereinafter “Vehmaanpera”), or Sung, USPN 5,759,840, issued June 2, 1998 (hereinafter “Sung”) for reasons set forth on page 19, of the OA.

The instant amendment addresses this issue; for example, all new claims and the claims as amended are now limited to methods encompassing use of polypeptides having at least about 90% sequence identity to SEQ ID NO:160, or equivalent.

According, in light of the instant amendment and these remarks, Applicants respectfully submit that the rejection under section 102(b) can be properly withdrawn.

## CONCLUSION

In view of the foregoing amendment and remarks, Applicants respectfully aver that the Examiner can properly withdraw the objections to and rejection of the pending claims under 35 U.S.C. §112, first and second paragraphs; 35 U.S.C. §102(b). In view of the above, claims in this application after entry of the instant amendment are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 564462007901. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at 858 7205133.

Dated: September 16, 2008

Respectfully submitted,

By /Gregory P. Einhorn/  
Gregory P. Einhorn  
Registration No.: 38,440  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, California 92130-2040  
(858) 720-5133 direct line  
general office 858 720 5100  
fax direct 858 523 5933  
fax office 858 720 5125  
email geinhorn@mofo.com